

Serial No. 10/692,426

REMARKS

The Office action dated September 9, 2004 and the cited references have been carefully considered.

Status of the Claims

Claims 1-5 are pending.

Claim 3 is objected to as being dependent on a rejected base claim, but would be allowable if rewritten in independent form. Claim 3 has been rewritten in independent form to include all of the limitations of the base claim and any intervening claims. Therefore, claim 3 is now in condition for allowance. Early allowance is respectfully requested.

Claims 1, 2, 4, and 5 are rejected under 35 U.S.C. § 102(b) as being anticipated by Gaylord (U.S. Patent 3,808,178). The applicants respectfully traverse all of this rejection for the reasons set forth below.

Remarks on the Amendments to the Claims

Support for the limitation of "each R group comprises an aromatic group covalently attached to a linking group" in amended claim 1 is found, for example, in the non-limiting examples of the aromatic-based side groups disclosed in paragraph [0015] and Table 1 of the original specification. The applicants wish to emphasize that although the scope of the claims is not limited by any particular embodiment of the claimed invention, a non-limiting method of synthesizing an aromatic-based siloxane macromonomer of the present invention is disclosed in paragraph [0016]. Such a macromonomer can be made by a two-step process. In the first step, a silicone hydride-containing macromonomer is made. In the second step, this silicone-hydride macromonomer is reacted with an allylic functionalized aromatic to attach the aromatic group to the silicon atom. Thus, the side group R comprises the aromatic group covalently attached to the linking group.

Claim Rejection Under 35 U.S.C. § 102

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Claims 1, 2, 4, and 5 are rejected under 35 U.S.C. § 102(b) as being anticipated by Gaylord. The applicants respectfully traverse this rejection because Gaylord does not disclose each and every element of each of claims 1, 2, 4, and 5.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a *single* prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). "Every element of the claimed invention must be *literally* present, arranged as in the claim. . . . The identical invention must be shown in as complete detail as is contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989) (emphasis added).

Gaylord discloses only phenyl side groups. Column 1, line 70 to column 2, line 6. In particular, Gaylor discloses triphenyldimethylsiloxanylmethyl acrylate. Column 2, lines 45-50. Gaylor does not disclose any other aromatic side groups.

In contradistinction, each of claims 1, 2, 4, and 5 recites side groups R, each comprising an aromatic group covalently attached to a linking group.

Since Gaylord does not disclose each and every element of each of claims 1, 2, 4, and 5, Gaylord does not anticipate these claims.

In view of the above, it is submitted that the claims are patentable and in condition for allowance. Reconsideration of the rejection is requested. Allowance of the claims at an early date is solicited.

Respectfully submitted,



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